

Appln No. 09/938,117

Amdt date July 7, 2006

Reply to Office action of March 9, 2006

### REMARKS/ARGUMENTS

#### Pending Claims:

Claims 1, 4, 5, 8, and 9-12 are pending herein, with claims 9 and 11 being amended to overcome 35 U.S.C. §112, 2<sup>nd</sup> grounds of rejection, as suggested by the Examiner.

#### Claim Rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph:

The Examiner rejects claims 9 and 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which Applicant regards as the invention. The Examiner suggested possible new terminology for claims 9 and 11, which Applicant adopts herein by amending these claims. Accordingly, the 35 U.S.C. Section 112, second paragraph ground of rejection falls away.

#### Claim Rejection under 35 U.S.C. §103(a):

The Examiner rejects claims 1-12 (*sic*- should be 1, 4, 5, 8, and 9-12) as being unpatentable over Herbert (U.S. Patent No. 6,102,592) in further view of Pierce (EPO Patent Application EP0927956). The Examiner states that Herbert discloses a postage indicium fraud detection method for permitting the automated processing of void mail pieces bearing a unique indicium, and which first unique indicium identifies the mail piece as being a void mail piece and is sorted from mail pieces not bearing the unique indicium by automated mail handling equipment. The Examiner admits that Herbert fails to explicitly explain printing a first unique indicium on a mail piece or label to be applied to a mail piece, the first indicia comprising at least one of a unique facing identification marking (FIM) different from FIM A, FIM B, and FIM C, and a unique postal numeric encoding technique (POSTNET) barcode that does not correspond to an actual zip code. The Examiner states that Pierce discloses at page 2, paragraph 0007, that a host produces the mail piece front including the return address, delivery address, and the facing identification marking (FIM), including POSTNET delivery point bar code. The Examiner states that Pierce further explains that the host may print this unit on the actual mail piece. From this, the Examiner states that it would have been obvious for one of ordinary skill in

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the art at the time the invention was made to modify Herbert's method in conjunction with Pierce's method to emulate an invention that deals with permitting automated processing of void mail pieces that has printing FIM corresponding to an actual zip code. Herbert's motivation is said to modify this invention to until FIM pertaining to zip codes would allow fraud to be detected.

Applicant has carefully studied the Herbert patent and the Pierce published application, and respectfully submits that one having ordinary skill in the art would not be motivated to combine the references, and even if they did, would not find the combination obvious. Firstly, the Herbert patent is directed to a method and apparatus for printing and preventing the copying of postage indicia, it does so by using a specialized ink that is rendered invisible when subjected to light or light and heat of sufficient intensity, such as developed by a photocopying machine. Thus, in Herbert, when an attempt is made to copy the imprint of a postage indicia on a mail item for which proper accounting has been effected, the ink becomes invisible, thereby revealing a message such as "VOID", which appears on the copied version, rendering it invalid for posting. The published European patent application, on the other hand, discloses a method for removing postal funds from a postage meter and is not at all directed to a method for permitting the automated processing of void mail pieces bearing a unique indicium, such as the case with a dishonest user who may try to use sample printed mail pieces on actual mail pieces to be posted. Accordingly, one skilled in the art would find no motivation to combine the references since they are related to very different problems. However, even if they were combined, they would not render the claimed invention obvious. Moreover, while Pierce does disclose printing of a unique POSTNET bar code that does not correspond to an actual zip code, it does not disclose a unique facing indication mark (FIM) that is different from a FIM A, FIM B and FIM C. The advantage of a unique FIM marking is that mail processing equipment is readily set up to separate mail pieces based on the FIM mark and it would be relatively simple for mail processing equipment to be programmed to direct mail pieces bearing the unique FIM to a separate location where they can be further processed if desired. On the other hand, the "VOID" indication that would appear if a user illicitly photocopied a mailpiece would not processed properly by the mail processing

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equipment since "VOID" is not a facing indication mark. So, even if Herbert and Pierce were to be combined, the claimed combination would still not make the claimed invention obvious.

Accordingly, Applicant respectfully submits that it would not have been obvious for one of ordinary skill in the art at the time the invention was made to modify Herbert's method in conjunction with Pierce to arrive at Applicant's claimed invention. Reversal is therefore requested.

The Examiner next rejects claim 4 as being obvious over Herbert. The Examiner states that Herbert discloses a method where an additional indicium comprises a unique postal alphanumeric encoding technology bar code printed on the mail piece or label for the mail piece which unique postal alphanumeric encoding technology bar code is used to at least one to identify the sender of the void mail piece, the time of the void mail handling and collect statistics on attempts to mail void mail pieces by the sender, and refers Applicant to Figure 5. The Examiner further states that Figure 5 illustrates a postage meter with two printing stations and that the mail piece bears destination information and postage indicia printed.

Applicant respectfully submits that Herbert is devoid of any teaching or suggestion whatsoever of using a unique postal alphanumeric encoding technology bar code. Indeed, nowhere in the specification is any postal alphanumeric encoding technology mentioned nor is there any mention whatsoever of using such a bar code to at least one of identify the sender of a void mail piece, the time of the handling or collect statistics. The Herbert reference does mention that the postage meter itself includes electronic accounting and control means. However, this is nothing unique, all postage meters do have such accounting functions to account for postage as it is applied to a mail piece. However, the subject matter of claim 4 is completely different in that it is directed to the POSTNET bar code which can be read by the mail handling equipment when the mail piece is processed. Again, nothing of the sort is disclosed or suggested by Herbert. Accordingly, Applicant requests that this rejection with regard to claim 4 is withdrawn.

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The Examiner raises the same basis for rejection as with the rejection of claim 1. Applicant in turn respectfully submits that for the same reasons claim 1 should be allowable, so should claim 5.

The Examiner rejects claim 8 using the same argument as for the rejection of claim 4, and Applicant's remarks with claim 4 are reiterated herein. Therefore, claim 8 should be allowed.

With regard to claim 10, claim 10 reads the same as claims 4 and 8, except that it is dependent on independent claim 9. Accordingly, it too should be allowed.

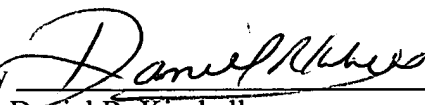
Next, the Examiner rejects claim 11 under Herbert in view of Pierce and makes the same arguments with respect to the rejection of claim 1 and 8. For the same reasons that claims 1 and 8 should be allowable, so too should claim 11.

Lastly, the Examiner rejects claim 12 for the same reason that claims 4, 8 and 10 are rejected. Applicant submits that for the same reasons that claims 4, 8 and 10 should be allowable, so should claim 12 which is dependent on independent claim 11.

Inasmuch as this case is rejected under final, if the Examiner has any remaining issues or if the Examiner has any alternative suggestions, a telephone call to the undersigned would be appreciated.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By   
Daniel R. Kimbell  
Reg. No. 34,849  
626/795-9900

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